



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

WOLF GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON MA 02210-2206

COPY MAILED

SEP 03 2009

OFFICE OF PETITIONS

In re Application of :
Tuschl et al. :
Application No. 09/821,832 :
Filed: March 30, 2001 :
Attorney Docket No. 0399.2008-002 :

ON PETITION

This is a decision on the petitions under 37 CFR §§ 1.36(a) and 1.183, filed July 20, 2009 and supplemented August 10, 2009, on behalf of Max-Planck-Gesellschaft Zur Forderung Der Wissenschaften E.V. (Max-Planck), requesting revocation of power of attorney and waiver of the requirement of 37 CFR 1.32(b)(4) for appointment of power of attorney by less than all of the applicants or owners. This decision also addresses the response in opposition filed July 31, 2009 on behalf of Whitehead Institute for Biomedical Research (Whitehead), Massachusetts Institute of Technology (M.I.T.), and the University of Massachusetts (UMass).

The petitions are **GRANTED** to the extent indicated below.

Petitioner, Max-Planck, requests the USPTO to: (1) waive the single signature requirements of Rule 1.32(b)(4) due to an ongoing dispute, including litigation, with both the co-assignees and the practitioners at Wolf Greenfield & Sacks, P.C.; and (2) allow the appointment of attorneys Robert B. Murray Reg. No. 22,980, Nancy Linck Reg. No. 31,920, and Monica Kitts Reg. No. 36,105 as its representatives before the USPTO.

The application as filed named Thomas Tuschl (Tuschl), Phillip D. Zamore (Zamore), Phillip A. Sharp (Sharp), and David P. Bartel (Bartel) as inventors. The assignment records of the USPTO indicate: at reel/frame 012089/0934 that Tuschl assigned his rights to both Max-Planck and Whitehead, at reel/frame 012089/0914 that Zamore assigned his rights to UMass, at reel/frame 012089/0942 that Sharp assigned his rights to M.I.T., and at reel/frame 012089/0904 that Bartel assigned his rights to Whitehead. However, the recording of a document pursuant to 37 CFR 3.11 is **not** a determination by the USPTO of the validity of the document *per se* or the effect that document has on the title to a patent or application. Such a determination must be made by a court of appropriate jurisdiction. Nonetheless, USPTO assignment records do suggest that Max-Planck has an interest in the instant application such that none of the co-assignees own the entire right, title and interest in this application. See *Ethicon, Inc. v. United States Surgical Corp.*, 135

F.3d 1456, 1465, 45 USPQ2d 1545, 1552 (Fed. Cir. 1998), *cert denied*, 525 U.S. 923 (1998). The co-assignees are each but a *partial* assignee. *But see* 37 CFR 3.71(b)(2).

Only the owner of the *entire* right, title and interest in an application has the sole right to control prosecution of an application. *See In re Goldstein*, 16 USPQ2d 1963, 1964 (Comm'r Pat. 1988); see also *In re Scold*, 195 USPQ 335, 336 (Comm'r Pat. 1976); *Ex parte Harrison*, 1925 Dec. Comm'r Pat. 122, 123 (Comm'r Pat. 1924). The procedures set forth in the regulations (*e.g.*, 37 CFR §§ 1.36, 3.71, and 3.73(b)) serve to assure that papers filed with USPTO in an application or patent are submitted on behalf of the owner(s) of the *entire* right, title and interest in the application or patent. *See Goldstein*, 16 USPQ2d at 1964. Nonetheless, papers revoking a power of attorney in an application (or giving a power of attorney) will be accepted by the Office when signed by less than all of the applicants or owners of the application when they are accompanied by a petition under 37 CFR 1.36(a) and fee under 37 CFR 1.17(f) with a showing of sufficient cause (if revocation), or a petition under 37 CFR 1.183 and fee under 37 CFR 1.17(f) (if appointment) demonstrating the extraordinary situation where justice requires waiver of the requirement of 37 CFR 1.32(b)(4) that the applicant, or the assignee of the entire interest of the applicant sign the power of attorney. *See* MPEP 402.10.

The response filed July 31, 2009 asserts that the sole right to control the instant application is set by contract. However, agreements made by contract are not construed by the USPTO in relation to the revocation and appointment of power of attorney since state law governs contractual obligations and transfers of property rights, including those relating to patents. *See Regents of the University of New Mexico v. Knight*, 66 USPQ2d 1001, 1008 (Fed. Cir. 2003). If a court clearly decides this matter, the court decision and the appropriate power of attorney documents should be promptly filed in this application. Absent a clear determination by an appropriate authority regarding representation of the parties in the instant application, the alleged contractual agreements that established representation in this case will not determine a party's sole right to control the case. Thus, the principles set forth in *In re Goldstein* remain valid here.

Also, the response's speculation that Max-Planck is motivated by nefarious purposes and should not be able to appoint counsel of its choosing is not relevant since a party's future intent is not considered by the USPTO in this situation. The Office is not the best forum in which to determine a party's intent. Such intent is best determined when the trier of facts can observe demeanor of witnesses subjected to cross-examination. A court, with subpoena power, is presently the best forum to consider such an issue. The court proceeding involves two participating adverse parties and the courts, not the Office, are in the best position to fashion an equitable remedy to fit the precise facts of the case. Accordingly, the speculated intent of Max-Planck will not determine that party's representation in this application. Moreover, any future harm caused by the actions (or inactions) of Max-Planck may find relief in a court of appropriate jurisdiction.

Since Max-Planck and the other co-assignees have divergent interests, no one side can reasonably expect or be permitted to control the prosecution of this application to the exclusion of the others. Furthermore, denying Max-Planck the ability to choose its own counsel and

requiring Max-Planck to have its interests represented by an opposing party in litigation would not be appropriate for the USPTO. The ongoing disputes, including litigation, between Max-Planck and both the co-assignees and the practitioners at Wolf Greenfield & Sacks, P.C provide sufficient cause for Max-Planck to revoke a power of attorney that it previously gave and an extraordinary situation where justice requires waiver of the requirement of 37 CFR 1.32(b)(4) so that Max-Planck may appoint counsel of its choosing.

In accordance with MPEP 402.10, the requested appointment of Robert B. Murray Reg. No. 22,980, Nancy Linck Reg. No. 31,920, and Monica Kitts Reg. No. 36,105 to represent Max-Planck is **granted** as of the mail date of this decision. The revocation and appointment of new counsel applies only to Max-Planck and those to whom it's right, title and interest are assigned. The practitioners of Wolf Greenfield & Sacks, P.C may continue to represent the other co-assignees.

In order to assure that all interests are properly and effectively represented, further correspondence to the United States Patent and Trademark Office (USPTO) in this application – or resultant patent—must be signed by both: (1) a registered practitioner representing Max-Planck; and (2) a registered practitioner representing the interests of the other co-assignees. Any counsel when signing subsequent papers must indicate whom he or she represents.

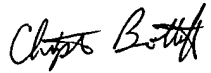
Since there is no agreement between the parties as to the correspondence address, the correspondence address for this application will remain with Wolf Greenfield & Sacks, P.C, as they were first named in the application. *See* MPEP 402.10. Also, Wolf Greenfield & Sacks, P.C will be responsible for coordinating replies or submissions to the USPTO, unless the parties otherwise agree after the mailing date of this decision.

This decision is being mailed to the address of record for the above-identified application. In order to ensure that the requesting party is notified of the decision, the decision is also being forwarded to the address on the petition. However, future correspondences will be forwarded to the address of record unless the address is properly changed.

All parties are reminded that dual correspondence is not permitted, and will not be undertaken by the USPTO.

This application is being referred to Technology Center 1600. The Technology Center is advised that communications filed on or after the mailing date of this decision not signed in accordance with this decision must also be regarded as informal, and as such, to take the action it deems appropriate.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-6692.

A handwritten signature in black ink, appearing to read "Chris Bottorff", written in a cursive style.

Christopher Bottorff
Petitions Examiner
Office of Petitions

cc: Rothwell, Figg, Ernst & Manbeck, P.C.
1425 K Street, N.W.
Suite 800
Washington, D.C. 20005